

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on December 4, 2006, the Examiner rejected claims 12-15, 26-27, 35 and 37-41 under 35 U.S.C. § 103(a) as unpatentable over Skonecki (U.S. Patent No. 5,305,550) in view of Roulleau (U.S. Patent No. 5,142,976). Applicants respectfully traverse this rejection and submit that the claims are not rendered obvious by the cited art. The standard for a Section 103 rejection is set forth in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added).

Applicant respectfully submits that the references cited by the Examiner, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. Applicant also respectfully submits that there is no suggestion or motivation to combine the references in the manner suggested by the Examiner, and that one of skill in the art would not reasonably expect success in combining the references in the manner provided.

Section 103 specifically requires assessment of the invention "as a whole." The Federal Circuit explained that inventions typically are new combinations of existing principles or features. *Envtl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements"). The "as a whole" instruction in

title 35 prevents evaluation of the invention part by part. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004). The Federal Circuit further explained that

[w]ithout this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. [*Ruiz* at 1275.] This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result - often the essence of invention. *Id.*

Contrary to this reasoning, section 103 requires assessment of the invention as a whole. *Id.* This “as a whole” assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner. *Id.* In other words, section 103 requires some suggestion or motivation, before the invention itself, to make the new combination. See *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Princeton Biochemicals Inc. v. Beckman Coulter Inc., 411 F.3d 1332, 1337 (Fed. Cir. 2005).

Applicant does not contend that Skonecki does not teach a rose provided with a drawing on its petal. Nor does Applicant contend that Roulleau does not teach a repeatable pad-printed image on an egg. Applicant strongly contends, however, that the combination of Skonecki and Roulleau fails to teach Applicant’s claimed invention: the cited references fail to teach every limitation of the claims, and the Examiner has failed to show by the references themselves that one of skill in the art would be motivated to arrive at the claimed invention.

Applicant’s claimed invention (as in independent claims 35 and 37) requires a product comprising a group of flowers, each flower having a stem and one or more petals, wherein said one or more petal(s) is free of an etched or cut image; and a repeatable, identical, pad-printed image provided on said petal that is free from an etched or cut image. While Skonecki teaches an image on a flower petal, Skonecki clearly cannot be said to teach a repeatable, identical, pad-

printed image provided on flower petals. Similarly, while Roulleau teaches a repeatable pad-printed image on an egg, Roulleau clearly cannot be said to teach a repeatable, identical, pad-printed image provided on flower petals. In the Office Action, the Examiner glosses over this difference by indicating that Applicant's previous arguments have not been persuasive as the Roulleau system provides a pad-printed image on a delicate organic product, namely the surface of the egg. While Applicant understands the Examiner's point that an egg may be considered a "delicate organic product," the rigid surface of the egg is not similar to the easily-deformable delicate surface of a flower petal, and Applicant will now show why the proposed combination is not apt.

As set forth above, neither Roulleau nor Skonecki teaches a repeatable, identical, pad-printed image provided on flower petals. The rejection relies on the skill of one in the art to make a cognitive leap to Applicant's claimed invention by the proposed combination of Roulleau and Skonecki. However, one of skill in the art would not be motivated to combine references in the manner suggested by the Examiner. First, Applicant notes that the Examiner has not provided any citation to any passage of Skonecki or Roulleau as teaching that it would be desirable to combine the references in the manner proposed. This is contrary to the mandate of Section 103 and MPEP 706.02(j) requiring that the "teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Simply put, one of skill in the art would not be motivated by any part of Skonecki or Roulleau to combine the two references. In fact, each of the two references teaches away from such a combination when read properly. The flower-marking method of Skonecki uses a "hand-

held applicator” (Col 2 line 43) to provide a “unique” message or drawing. (Col 1 lines 33-35)

In contrast, the egg-marking machine of Roulleau uses a very specialized machine (not a hand-held applicator) to print a repeatable, non-unique decoration to the exterior of an egg. (Col 1 line 61-Col 2 line 11, Col 2 line 52-Col 3 line 10, Figure 1) The complex machine of Roulleau is used to provide the repeatable image on eggs of different sizes and shapes. (Col 1 lines 58-60, Col 2 lines 24-29) Although the eggs on which Roulleau’s machine prints can be considered “delicate” in one sense, Applicant’s claimed invention is not merely for printing on a “delicate” product, but for a repeatable, identical, pad-printed image on a flower petal still attached to a flower. The pad-printing machine of Roulleau is completely inadequate for providing such printing, and one of skill in the art, having access to both Skonecki and Roulleau would not find any teaching of either reference suggesting that the references could be combined to provide pad printing on flowers.

While eggs are “delicate” in that they are breakable after a certain amount of force is applied to them, one of skill in the art would also recognize that they are essentially rigid until that breaking point is reached. Therefore, a pad-printing method that appears to be adequate for eggs may be (and is) completely inadequate for flowers. Simply put, printing on a live flower petal is a completely different problem than printing on a rigid egg surface. Not only does the soft flower petal itself much more readily deform than does the rigid egg surface, but the flower petal also flexes or bends at its attachment to the flower stem while the egg surface is rigid throughout.

In recognizing the differences in rigidity between a flower petal and an egg, the problem for using the egg pad-printing machine of Roulleau for flowers then becomes readily apparent. Roulleau discloses printing using “tampography,” which is disclosed as consisting “in applying a

slightly convex flexible inking pad, or tampon, which has previously received the motif to be printed, to the object to be decorated.” (Col 1 lines 36-39) Of course, as the “tampon” is used to print on the outer surface of an egg, the slightly convex tampon must be deformed to a concave state as it is pressed against the surface of the egg. (See Col 1 lines 49-52 and lines 58-60) Even if the “tampon” is significantly flexible in order to provide for this deformation, some relatively large force must be applied to cause the deformation. For example, Roulleau discloses that the tampography printing process may break an already cracked egg (Col 2 lines 45-46), and for this very purpose, the machine is designed to have a conveyor with an open center to allow the broken egg contents to flow out without requiring the machine to be stopped and cleaned. (Col 2 lines 46-49, Figure 1) One of skill in the art would readily appreciate from this disclosure that the tampography process disclosed by Roulleau provides a significant force in printing on the egg.

Roulleau also discloses that the tampon used in the tampography process is applied using a very fixed and rigid mechanism, namely a “screw jack.” (Col 2 line 67-Col 3 line 4) This means that the tampon always moves back and forth through exactly the same range of motion, and this is disclosed as being necessary and advantageous so as to allow printing parts of the decoration in different colors with successive tampons. (Col 3 lines 5-7, see Figure 1) One of skill in the art, when viewing this rigid machine system of Roulleau and being aware of the force necessary to print using tampography process (that can break an already cracked egg) would never view the Roulleau system as being adequate for printing on a live flower petal still attached to the flower.

Specifically, even assuming that Roulleau’s machine could be modified to hold a flower, Roulleau’s machine with its faceted conveyor (see Figure 1 and Col 2 lines 54-68) is designed to

hold a regularly-shaped symmetrical egg. On an egg, it simply does not matter if the egg is rotated about its axis 30 degrees, 60 degrees, or some other rotation before printing begins; the printing will look exactly the same. On a flower, the rotation is highly important and different from the egg-printing process. For example, using the machine of Roulleau, if the rotation is not exactly right, the printing might fall on two or more petals, interrupting the image (especially if one of the printed petals is later lost or falls off).

Additionally, even assuming a flower is properly initially aligned in the system of Roulleau, the force necessary to deform the tampon to provide the printing will first displace the flower petal out of its proper initial alignment as it simultaneously deforms the flower petal. It is highly unbelievable that a tampon could be designed for Roulleau's screw-jack-driven system that would not first displace and deform the flower petal before the tampon properly deforms to provide the image on the flower petal surface.

By way of example and experiment, Applicant invites the Examiner to conduct a simple object lesson that shows why Roulleau's system is inadequate for the task of printing on flowers. Applicant invites the Examiner to crack, but not break open, an ordinary egg. Applicant then invites the Examiner to hold a flower, such as a rose, by the stem near the flower, and to then press down on the cracked egg with the flower until either the flower petal making contact with the egg is significantly deformed or forced out of position or the egg breaks open and spills its contents. This experiment will readily show that the tampography printing method of Roulleau that is disclosed as using force sufficient to break a cracked egg would be completely inadequate for printing on flowers: the deformation and displacement of the flower petal will simply result in an unacceptably smudged and/or incomplete and unpleasant image.

Applicant therefore strongly maintains that Roulleau's machine for printing on rigid eggs is inadequate for printing on flowers, and that one of skill in the art would therefore never be motivated to make the combination proposed by the Examiner.


Thus, for at least the foregoing reasons, Applicant respectfully submits that the references cited herein do not render obvious the independent claims. In addition, dependent claims place further limitations on otherwise allowable subject matter. Accordingly, Applicant respectfully submits that the cited references do not make obvious the claim set provided herein.

CONCLUSION

Applicant submits that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, or if the Examiner would like to suggest amended claim language, the Examiner is invited to call the undersigned.

DATED this 4 day of April, 2007.

Respectfully submitted,


Michael F. Krieger
Attorney for Applicant
Registration No. 35,232

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 321-4814
Facsimile: (801) 321-4893